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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,441	09/30/2003	Jorge Adams	03009-00	4133

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EXAMINER

DRODGE, JOSEPH W

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 12/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/674,441

Applicant(s)

ADAMS ET AL.

Examiner

Joseph W. Drodge

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>12012006</u> . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

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Claims 26-28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 19 and 21 of copending Application No. 10/892,847. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims differ from claim 19 of '847 in either omitting the surfactant (claim 26) or including both an emulsifier and a surfactant, rather than merely a surfactant (claim 27). However the instant claims and claims of '847 commonly claim a composition with elements of oil-based mud, water-in-oil emulsion and polymer derived from water-soluble monomer.

Claim 3 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/892,847, in view of claim 19 of '847. Claim 1 of '847 differs from instant claim 3 primarily in now also reciting the step of using a surfactant. However, claim 19 discloses oil-based mud contacting compositions as containing surfactant.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In each of claims 1 and 26 the added limitation "wherein the average discrete phase particle size..." lacks clear antecedent basis, see the section of the Office Action labeled "Allowable Subject Matter" for recommendation on resolving this problem.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 26-28 remain rejected under 35 U.S.C. 102(b) as being anticipated by Dymond et al patent 4,777,200. Dymond et al '200 disclose compositions comprising oil-based drilling mud (column 2, lines 35-44 and column 5, lines 5-12), a water-in-oil emulsion comprising a water soluble polymer (column 4, lines 57-68). It is immaterial whether the polymer is dissolved prior to contacting the mud, since only the composition end product is claimed. The composition contains particles of an average particle size of less than 10 microns (Abstract).

Also disclosed are addition of emulsifiers, surfactant and water (column 3, lines 25-30 and lines 52-59) for claim 27; regarding claim 28, the composition is "well-dispersed" (column 4, lines 59-67).

Applicant's arguments filed on October 20, 2006, with respect to claims 26-28 have been fully considered but they are not persuasive.

It is argued that regarding claims 26-28, Dymond does not disclose a water-in-oil emulsion comprising a water soluble polymer or a composition effective for functioning as flocculents. It is submitted that Dymond explicitly discloses such water-in-oil emulsion and contained polymer at column 4, lines 55-67. The composition claim does not positively recite a flocculent.

It is argued that in Dymond, the polymer is oil-soluble and as a consequence, the polymer no longer has discrete particles when combined with the oil-based drilling mud. However, the instant claims merely require that the polymer be derived from or comprise at least one water-soluble monomer. The Dymond polymers contain both oil-soluble or water-insoluble and water-soluble monomers. The particles themselves in Dymond remain insoluble and thus remain discrete in the water-immiscible or oily liquid (last 5 lines of the Abstract).

ALLOWABLE SUBJECT MATTER

Pending resolution of double patenting rejection, independent claim 1 would distinguish if amended to recite "contacting...prior to contact with said oil-based mud ***[and] wherein the emulsion comprises polymer particles of average discrete phase particle size of [the polymer] less than about 10 microns...***" ***It is acknowledged that neither of the applied prior art references, Chen or Thompson, suggest such polymer particles applied to separate solids from liquid in an oil-based mud.***

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It is suggested that claim 26 be similarly amended to mitigate the 112, 2nd paragraph rejection. Applicant's representative proposed amending claim 26 to insert that the water-in-oil emulsion is comprising a continuous oil phase and discontinuous aqueous phase which is in the form of droplets or particles; however, it is unclear if such amendment substantially clarifies or narrows the claim, or merely recite conventional features of water-in-oil emulsions.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Drodge at telephone number 571-272-1140. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached at 571-272-1151. The fax phone number for the examining group where this application is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or Public PAIR, and through Private PAIR only for unpublished applications. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JWD

December 1, 2006

Joseph Drodge
Primary Patent Examiner